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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,031	04/26/2000	JOSE RAFAEL ESTEBAN DURAN	P/613-111	7856

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EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 08/13/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/508,031	ESTEBAN DURAN ET AL.	
	Examiner	Art Unit	
	Susan Coe	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____ .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

1. This action is a supplemental action in place of the Office Action of March 28, 2002. This action is in view of the correct set of claims as discussed in the petition that was granted June 13, 2002.

2. Claims 1-6 and 8-14 are currently pending.

Election/Restrictions

3. Applicant's election with traverse of ethyl acetate and ethanol for species A, phenol and acetoin for species B, and sugar cane for species C in Paper No. 8, dated January 16, 2002 is acknowledged. The traversal is on the ground(s) that Giblin-Davis does not anticipate claim 1. This is not found persuasive because this reference is still considered to anticipate claim 1 in its original form. Giblin-Davis teaches using a combination of sugar cane and ethyl acetate to attract insects (see page 1394, third paragraph). In addition, applicant's argue that the mixture of ingredients in the current form of claim 1 is allowable because the mixture shows unexpected results. However, this is not persuasive because the numerous embodiments represented by the species in claim 1 would still be burdensome to search. In addition, the data presented by applicant does not show unexpected results for the elected species or for all of the possible embodiments encompassed by claim 1. Therefore, this allegation of unexpected results is not found to have support in the specification.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1651

4. Claim 11 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.
5. Claims 1-6, 8-10, and 12-14 are examined on the merits.

Priority

Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Spain on September, 5, 1997. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-10, and 12-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is indefinite because it is not clear what are considered by applicant to be the “vegetal portions” of the plants.
7. Claim 2 recites the limitation "said component (a1)." There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, component (a1) is assumed to correspond to component (a) in claim 1.
8. Claim 3 recites the limitation "said component (a2)." There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, component (a2) is assumed to correspond to component (c) in claim 1.
9. Claim 8 is indefinite because it states that component (b) can be present in 0%. This limitation conflicts with claim 1 which requires component (b) as an ingredient in the composition.
10. Claim 10 is indefinite because it contains 40% ethyl acetate, 40% ethanol, and 20% sugar cane. However, claim 1 also requires the additional ingredients from component (b) that cannot be added to the composition specified by claim 10 because these ingredients would increase the weight to over 100%.
11. Claim 12 is indefinite because the meaning of the phrases “pests of insects” in line 1 and “the insect the pest” in line 4 are unclear. In addition, it is unclear what insects are considered to “pertain” to the *Coleoptera* order.

12. Claim 13 is indefinite because the meaning of the phrases “pests of insects” in line 1 and “the insect the pest” in line 4 are unclear. In addition, it is unclear what insects are considered to “pertain” to the *Coleoptera* order. The phrase “loaded with the feromone” in lines 3 and 4 is indefinite because it is not clear what limitations this phrase is meant to give to the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-6, 8-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe et al. (Journal of Chem Ecol (1993), vol. 19, no. 8, pp. 1703-1720) in view of Umano et al. (J. Agric. Food Chem. (1992), vol. 40, no. 4, pp. 599-603) and Nagnan et al. (Oleagineux (1992), vol. 47, no. 3, pp. 135-142).

The claims are directed towards a composition that can be used to attract *Coleoptera* insects. The composition comprises ethanol, ethyl acetate, acetoin, phenol, sugar cane, and a pheromone.

Jaffe teaches that *Coleoptera* insects such as the palm weevil can be attracted using baits of various compositions. One specific bait contains pheromone, sugar cane, ethyl acetate, and ethanol (see page 1717, third paragraph). Jaffe does not specifically teach using phenol or acetoin in the bait composition; however, Jaffe does state that the odors produced by damaged plant tissue from pineapple are attractive to these insects (see page 1704).

Umano teaches that both acetoin and phenol are odor components from pineapple (see Table 1). Based on the teaching by Jaffe that pineapple odors are attractive to palm weevils, and by Umano that phenol and acetoin are components of pineapple odor, a person of ordinary skill in the art would have a reasonable expectation that adding acetoin and phenol to the bait composition of Jaffe would be successful. Therefore, an artisan of ordinary skill would have been motivated to add phenol and acetoin to the composition of Jaffe based on the teaching by Umano that these ingredients are components of pineapple aroma.

In addition, Nagnan teaches that acetoin (3-hydroxy-2-butanone) is a component in palm wine (see Table I). This palm wine is attractive to palm weevils (see page 135). Based on the teaching by Nagnan that acetoin is a component in palm wine that could be attractive to the palm weevil, an artisan of ordinary skill would have a reasonable expectation that adding acetoin to the bait composition of Jaffe would be beneficial. Therefore, a person of ordinary skill in the art would have been motivated to add acetoin to the composition of Jaffe based on the teaching by Nagnan.

These references teach a combination of ethanol, ethyl acetate, acetoin, phenol, sugar cane, and a pheromone; however, they do not teach stabilizing the sugar cane with a ascorbic acid or citric acid. However, these acids are well known in the art to be added to food containing compositions in order to stabilize the composition against spoilage. Thus, a person of ordinary skill in the art would expect that the addition of these acids to a composition containing sugar cane would be a beneficial modification. An artisan of ordinary skill in the art would have been motivated to add these acids to the sugar cane based on the benefits of these acids that is known in the art.

The references also do not teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

The references also do not teach that the composition is useful in controlling pests in sugar cane, banana trees, or agaves. However, it was known in the art at the time of the invention that *Coleoptera* insects were pests of these plants. Therefore, a person of ordinary skill in the art would be motivated to use the composition taught by the combination of the references to control insects in these plants.

Art Unit: 1651


14. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC
August 6, 2002



LEON B. LANKFORD, JR.
PRIMARY EXAMINER